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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,787	02/06/2004	Sanjay Shah	GOLDSTAR 3.0-007	7914

7590

02/08/2005

EZRA SUTTON, P.A.  
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EXAMINER
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REESE, DAVID C

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/773,787

Applicant(s)

SIEBENBERG, ET AL.

Examiner

David C. Reese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Status of Claims*

- [1] Claims 1-20 are pending.

### *Specification*

- [2] The abstract of the disclosure is objected to:

The length of the abstract is too long, as it should be limited to within a range of 50 to 150 words. Please read below. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

- [3] The disclosure is objected to because of the following informalities:

In Line 6, "( each triangular-shaped)," should be, "(each triangular-shaped).

Appropriate correction is required.

*Claim Rejections - 35 USC § 103*

[4] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[5] Claims 1-6, 11, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan, US-D460,018 in view of Wolf, US-D431,011, and in further view of Gurevich, US-6,442,971.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

Chan teaches of a jewelry setting for receiving triangular-shaped gemstones or diamonds in the setting utilizing prongs and ultimately forming an oval arrangement.

However, Chan fails to disclose expressly of using other gemstone shapes or other arrangements for the gemstones different than that of an oval arrangement. Chan also does not specifically show of a base containing bar members.

Wolf teaches of a gemstone embodiment revolving around a different, more precise version of a triangular gemstone structure; while Gurevich teaches of a multi-stone round center

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setting for diamonds and gemstones including crossbars to help create specific seats for the individual gemstones within the jewelry setting.

At the time of invention, it would have been obvious to one of ordinary skill in the art to modify the jewelry setting as taught by Chan, to incorporate an additional embodiment of triangular structure as suggested by Wolf, with additional base structures suggested by Gurevich, giving way to an embodiment of a jewelry setting by substituting the base members of Gurevich (36, 38 in Fig. 1) into the base of Chan and the gemstone of Wolf (Figure 1) for each of the four gemstones of Chan, and thus by such a substitution, the outside structure of the jewelry setting of Chan will be substantially rectangular-shaped and the individual triangular-shaped gemstones will be concretely positioned within specific seats providing another design choice for the user as described further below, as well as a more engaging environment for the gemstones to remain seated in.

Continuing, it would have been an obvious matter of design choice to modify the jewelry setting of Chan by substituting another embodiment of a triangular gemstone (Wolf) into the jewelry setting of Chan, since applicant has not disclosed that the substantially rectangular-shaped gemstone or diamond arrangement, that is, the rectangular shape, solves any stated problem or is of any particular purpose and it appears that different shapes would equally perform well as substitutes, as a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Now as for Claim 1, Chan in view of Wolf and in further view of Gurevich teach of a multi-gemstone arrangement and a prong setting for receiving four substantially triangular-

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shaped gemstones or diamonds in the setting for forming a substantially rectangular-shaped gemstone or diamond arrangement; comprising:

- a) a prong setting including a prong assembly having four prong members (four members as shown in Fig. 1 of Chan);
- b) an upper rail assembly having four side rail members and four corner rail members; said four corner rail members being attached to said four prong members (the members found between prongs and around the gemstone as viewed in Figs. 3 and 4 of Chan, as well as 28 in Fig. 1 of Gurevich), respectively;
- c) an upper frame assembly having first and second crossbar members, said first crossbar member having first outer ends and said second crossbar member having second outer ends (Chan in view of Gurevich and Wolf, that is, substituting the triangular gemstone of Wolf for the gemstones of Chan, while maintaining cross-bars similar to that suggested by Gurevich, but in the X-pattern as shown by Chan);
- d) said first and second crossbar members forming an X shaped configuration and each being connected at their respective first and second outer ends thereof to said corner rail members for forming four seating areas (Chan in view of Gurevich and Wolf, that is, substituting the triangular gemstone of Wolf for the gemstones of Chan, while maintaining cross-bars similar to that suggested by Gurevich, but in the X-pattern as shown by Chan);
- e) each of said four seating areas for receiving therein one of said four triangular-shaped gemstones or diamonds within each of said four seating areas (Chan in view of Gurevich and Wolf, that is, substituting the triangular gemstone of Wolf for the gemstones of Chan, while

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maintaining cross-bars similar to that suggested by Gurevich, but in the X-pattern as shown by Chan);

f) said four-triangular shaped gemstones or diamonds each having three side walls and each having first and second retaining corners and a third apex corner (the gemstone as taught by Wolf in Figs. 1-4), respectively; each of said first and second retaining corners forming a corner retaining angle with at least two of said side walls (Chan in view of Gurevich and Wolf, that is, substituting the triangular gemstone of Wolf for the gemstones of Chan, while maintaining cross-bars similar to that suggested by Gurevich, but in the X-pattern as shown by Chan);

g) each of said four prong members each having a retaining insert slot formed therein for receiving and engaging at least a portion of said first and second retaining corners of two adjacent gemstones or diamonds to keep said four gemstones or diamonds seated within each of said four seating areas of said prong setting (the notches in the prong members as viewed in Fig. 1 of Chan).

As for Claim 2, Chan teaches of multi-gemstone arrangement, Re: Claim 1, wherein each of said four prong members includes an upper prong end, a lower prong end, an exterior wall surface and an interior wall surface having a center section area (the prongs as shown by Chan in Figs. 1-4).

As for Claim 3, Chan teaches of multi-gemstone arrangement, Re: Claim 2, wherein each of said four corner nail members is attached to said interior wall surface at said center section area of each of said four prong members, respectively (Figs. 3 and 4 of Chan).

As for Claim 4, Chan teaches of multi-gemstone arrangement, Re: Claim 2, wherein each of said retaining insert slots is positioned at said upper prong end on said interior wall surface of each of said four prong members (the slots at the upper section of the prong members holding segments of two gemstones as shown in Figs. 1 and 2).

As for Claim 5, Chan teaches of multi-gemstone arrangement, Re: Claim 1, wherein said prong setting further includes a lower frame assembly having four lower frame side rail members for providing additional structural strength to said prong setting (lower side rail members as shown in Figs. 1, 3, and 4 of Chan).

As for Claim 6, Chan teaches of multi-gemstone arrangement, Re: Claim 2, wherein each of said lower frame side rail members is attached to said lower prong end of each of said four prong members, respectively (lower side rail members attached to the lower prong members as shown in Figs. 1, 3, and 4 of Chan).

As for Claim 11, Chan teaches of multi-gemstone arrangement, Re: Claim 1, wherein one of said three side walls of said triangular-shaped gemstone or diamond is an outer wall being adjacent and parallel with one of said four side rail members (Chan in view of Gurevich and Wolf, that is, substituting the triangular gemstone of Wolf for the gemstones of Chan, resulting in the one of the three side walls of the triangular gemstone being an outer wall of the overall structure).

As for Claim 16, Chan teaches of multi-gemstone arrangement, Re: Claim 1, wherein said corner retaining members of two adjacent triangular-shaped gemstones or diamonds have said corner retaining angles gamma and delta being in alignment with each other to cooperate in forming a straight edged corner member being received within each of said retaining insert slots



of said four prong members (Chan in view of Gurevich and Wolf, that is, substituting the triangular gemstone of Wolf for the gemstones of Chan, allowing the corners of the triangular gemstone of Wolf to be engaged within the slots of the prongs taught by Chan).

[6] Claims 7-10, 12-15, 17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan, US-D460,018 in view of Wolf, US-D431,011, and in further view of design choice.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

Multiple inventors disclose varying sizes and shapes of gemstones, as it is readily known within the art that such changes are necessary to accompany a specific design choice, and finalizing exact dimensions of a structure of an assembly for overall appearance purposes. It would have been obvious to one having ordinary skill in the art at the time the invention as made to create multi-stone embodiments with varying angles and corners as well as an environment catering to different size settings to account for different carat sizes as a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

[7] As for Claims 18 and 20, the examiner takes notice that creating parts of a jewelry setting or arrangements from metals such as gold, silver, etc, is readily an old and well-known design consideration to those familiar in the art. Also, the medium by which such jewelry arrangements

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are submitted to, such as a ring, necklace, pin, etc, is also a old and well-known design consideration to those familiar to the art, and are thus, obvious and not novel.

### *Conclusion*

[8] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited further to show the state of the art with respect to this particular type of gemstone arrangement; as well as their extreme relevance to the current application as many read extensively onto the claimed invention: Vartanian, D488,088; Benderly, D334,154; Wolf, D419,480; Fairbrother, Jr., 775,030; Pachauer, D482,636; Chan, D483,687; Smeja et al., 5,471,799; Siebenberg, 6,389,846; Cheung et al., D458,868; Chan, D422,935; Katz, D399,165; Giladi, US 2004/0182110; Siebenberg, 6,519,972; Lai, D460,381; Lai, D427,934; Chan, D468,660; Shah, D455,977; Cohen, D460,380; Chan, D423,980.

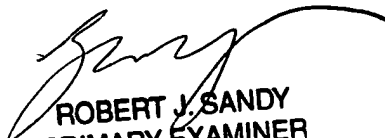
[9] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is 703-305-4805. The examiner can normally be reached on 7:30 am - 5:00 pm M-Th, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (703) 306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,  
David Reese  
Examiner  
Art Unit 3677



ROBERT J. SANDY  
PRIMARY EXAMINER